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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,540	11/25/2003	Junji Hayashi	Q78675	4398

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EXAMINER

BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/720,540	Applicant(s) HAYASHI ET AL.	
	Examiner David Buttner	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/25/03</u> . | 6) <input type="checkbox"/> Other: ____. |

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,3 and 7 rejected under 35 U.S.C. 102(b,e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rajagapolan '892.

Rajagapolan suggests golf balls having a core, at least one intermediate layer and a cover (abstract). The core is made from a polybutadiene such as Neocis BR40 or Ubepol150 (col 6 line 60). These are Nd catalyzed polybutadienes. One or more peroxides are used in the core at 0.25-1.5pph (col 7 line 33; table II) together with diacrylates (col 7 line 1) and filler (col 7 line 64). Tetramethylthiuram (col 8 line 19) can be present in the core. The ATTI compression of the core is 45-60 (col 6 line 35). This corresponds to applicant's deflection (see figure 7 of the Science and Golf Text). The core diameter is 1.25-1.51" (col 4 line 63). The Shore D of the intermediate layer and

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cover is 35-60 and 60-72 respectively (col 3 line 51-53). The intermediate layer is preferably 0.06" (col 10 line 47). The cover can be a polyurethane (col 10 line 57). The overall ball ATTI compression is preferably 82 (col 11 line 58) which corresponds to about 3.0mm on applicant's deflection scale (see figure 7 of the Science and Golf Text).

Claims 1,3,5 and 7 rejected under 35 U.S.C. 103(a) as being unpatentable over Rajagopalan '892 in view of Yamamoto '859.

Rajagopalan suggests clear coating the golf ball (col 12 line 66), but does not give any details of the coating.

Yamamoto (abstract) teaches the coating used by applicant is particularly suitable for golf balls. It would have been obvious to use Yamamoto's coating as the coating called for by Rajagopalan. Only the expected results are obtained.

Claims 1,3,7 and 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Rajagopalan '892 in view of Watanabe 2001/0055998.

Rajagopalan does not suggest dimpling his golf ball. Dimpling a golf ball cover is a well known technique in the art.

Watanabe (abstract) appears to disclose applicant's dimple geometry and that this geometry provides favorable flight characteristics (tables). It would have been obvious to provides this dimpling to Rajagopalan's ball for the expected benefits.

Claims 1-3 and 7 rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagishi EP908199 in view of Sone '505.

Yamagishi exemplifies (#1) a golf ball having a core, inner cover and a polyurethane outer cover. The sizes, thicknesses, Shore D and deflections meet

applicant's criteria. The core contains zinc pentachlorothiophenol, filler, peroxide zinc acrylate and polybutadiene. Yamagishi does not explain how the polybutadiene was polymerized.

Sone (table 1) produces applicant's preferred Nd catalyzed/modified polybutadiene. Sone teaches (table 3) this polybutadiene is superior to more conventional polybutadienes. It would have been obvious to utilize Sone's polybutadiene as the polybutadiene in Yamagishi's for the expected benefits.

Claims 1-4 and 7 rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagishi '646 in view of Sone '505 in further view of JP2002336378.

Ichikawa '100 is relied on as a translation of JP2002336378.

The Yamagishi/Sone combination suggests polyurethane covers, but not adding a diisocyanate to the polyurethane cover.

JP2002336378 teaches that inclusion of a diisocyanate into a urethane cover improves scuff (tables). It would have been obvious to add a diisocyanate to Yamagishi's cover for the expected benefits.

Voorheis '187 is cited for his description (col 6 line 17) of Neocis BR40 and Ubepol.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 and 6-8 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6786839. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims essentially the same ball where the cover requires a blend of polyurethane with another polymer. The current claims are broader in the sense that the "other" polymer is not required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Buttner

DAVID J. BUTTNER
PRIMARY EXAMINER

2/117/06

A handwritten signature in cursive script that reads "David Buttner".